

AMENDMENTS TO THE DRAWINGS

The attached sheet(s) of drawings includes changes to FIGURES 1, 2A and 2B.

Attachment: Three (3) Replacement Drawing Sheets

Applicant has amended the drawings to add text legends as follows:

Fig. 1: Element 11-1 (user device), 11-n (user device), 12-1 (user device), 12-n (user device), 13 (network) and 150 (network).

Fig. 2A: Element 12-m (user device), 11-m (user device), 11-1 (user device), 12-1 (user device), 13 (network) and 150 (network).

Fig. 2B: Element 11-1 (user device), 11-2 (user device), 11-3 (user device), 11-M (user device), 201 (advertisement device), 12-3 (user device), 12-M (user device), 214 (distributed servers/gateways), 215 (distributed servers/gateways).

REMARKS

I. Overview

Claims 1-55 are pending in the application. Examiner raised the following issues in the Office Action:

- 1) Examiner objects to the drawings for lacking text legends and for not showing every feature specified in the claims.
- 2) Examiner objects to the specification for failing to provide proper antecedent basis for “data rich.”
- 3) Examiner rejects claim 32 under 35 U.S.C. § 112 for failing to explain the phrase “data rich.”
- 4) Examiner rejects claims 1, 10, 32, 43 – 44 and 51 under 35 U.S.C. § 103(a) as being unpatentable over Pub. No. US 2003/0097463 A1 (hereinafter “Kageyama”) in view of Pub. No.: US 2003/0193951 A1) (hereinafter “Fenton”).
- 5) Examiner rejects claims 2 – 5 and 7 – 9 under 35 U.S.C. § 103(a) as being unpatentable over Kageyama and Fenton in view of U.S. Patent No. 7,139,252 B2 (hereinafter “Babu”).

Applicant respectfully requests reconsideration and withdrawal of the rejections and objections in light of the amendments and remarks contained herein.

II. Applicant’s Statement of the Substance of Interview

Applicant thanks Examiner for taking part in an interview regarding the current objections and rejections. As required by M.P.E.P. § 713.04, Applicant submits the following record of the telephone interview of May 27, 2008.

The following persons participated in the interview: Examiner Tauqir Hussain and Applicant’s attorney Wayne Livingstone. The participants discussed the rejections of the claims. Applicant’s attorney asserted that attributes of a second user device was distinct from Kageyama’s attribute information, at least, based on Kageyama paragraph [0060] and a

reasonable interpretation of the claim language. Examiner agreed with Applicant attorney's assertion as presented, but said that Examiner would have to review the applied art. Applicant's attorney also asserted that the applied art did not teach the limitation of claim 10 requiring, "a server . . . adapted to receive from a first user device . . . a message including identification of certain content of said stored content for sending at least a portion of said stored content to a second user device of said plurality of user devices as a multi-media message." Examiner suggested that Applicant replace the phrase "adapted to" in claim 10.

Applicant's attorney asserted that in claim 1, Applicant should not be required to show in a drawing, "configuring the content for delivery to said user device as a function of the attributes of said second user" as Examiner requests. Examiner agreed to withdraw this assertion.

Applicant's attorney also pointed out that "data rich" was recited in various paragraphs of the specification including, paragraphs [0023], [0024], [0026], [0027] and [0030]. Examiner noted that the phrase "data rich" might be interpreted broadly to mean any data. Applicant's attorney indicated that Applicant would submit a response taking into account this interview.

III. Amendments to the Drawings

Applicant has amended the drawings to recite text legends as Examiner requested. Applicant did not introduce new matter by these amendments.

IV. Objections to the Drawings

Examiner objected to the drawings under 37 C.F.R. § 1.82(a) for not showing "said user device as a function of the attributes of said second user" 37 C.F.R. § 1.81, however, provides that the drawings are required to facilitate the understanding of the invention. Applicant submits that a drawing is not required to understand the limitation "configuring . . . as a function of said attributes" As such, Applicant respectfully requests Examiner to withdraw this objection to the drawings.

V. Amendments to the Claims

Applicant has amended claim 1 to recite, "storing, in a media delivery system, content to be delivered from a first user device to a second user device, wherein said storing allows said media delivery system to accept information, pertaining to said stored content" This

amendment recites a limitation previously recited in claim 7 into claim 1. Accordingly, Applicant has amended claim 7 to remove that limitation. Support for the amendment to claim 1 may also be found in paragraphs [0021] to [0023] of the specification. Applicant has introduced no new matter by these amendments. Applicant has amended claim 10 to remove the phrase “adapted to.” Applicant has also amended claim 32 to make claim 32 clearer than it currently is.

VI. Objection to the Specification and Rejection of claim 32 under 35 U.S.C. § 112

Examiner objects to the specification as failing to adequately teach how to make and use the invention. Examiner asserts that Applicant has not disclosed “data rich message” in the specification. Based on this assertion, Examiner also rejects claim 32 under 35 U.S.C. § 112. “[T]he examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in [the] specification disclosure a description of the invention defined by the claims.”¹

Applicant rebuts Examiner’s assertion that the specification does not adequately teach how to make and use the invention. An enabling disclosure requires that Applicant conveys to one skilled in the art that Applicant had possession of the claimed concept.² The enablement requirement does not require Applicant to describe every detail.³ Moreover, Applicant is not required to explain a phrase if it is clear to one skilled in the art.⁴ Applicant submits that the phrase “data rich message” as used in the claims is clear to one skilled in the art. Paragraphs [0023], [0024], [0026], [0027] and [0030] of the specification use the phrase “data rich.” As such, there is antecedent basis for “data rich.” One skilled in the art would understand the meaning of “data rich” as it is used in these paragraphs. Applicant also use the phrases “messages which are preferably data rich,” “data rich message” and “messages which are data rich” to describe embodiments of the invention in paragraphs [0036], [0041] and [0044] respectively. Applicant believes the meaning of these terms as they are used in the specification is clear and adequately discloses, to one skilled in the art, the scope of claim 32.

¹ *Ex parte Sorenson*, 3 USPQ2d 1462, 1463 (B.P.A.I. 1987).

² *Ex parte Parks*, 30 USPQ2d 1234, 1236 (B.P.A.I. 1994).

³ *In re Gay*, 309 F.2d 769, 135 USPQ 311, 316 (C.C.P.A. 1962).

⁴ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (en banc) (The ordinary and customary meaning of a term may be evidenced by a variety of sources, including “the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.”)

Nonetheless, to make the scope of claim 32 clearer, Applicant has amended claim 32 to recite “wherein said data rich message is selected from the group consisting of: video data and audio data.” Support for this amendment may be found in paragraph [0023] of the specification. Based on Applicant’s remarks and the amendment of claim 32, Applicant respectfully requests that Examiner withdraw the rejection of claim 32 and the corresponding objection to the specification for not explaining “data rich message.”

VII. Rejections Under 35 U.S.C. § 103

Examiner rejects claims 1, 10, 32, 43 – 44 and 51 under 35 U.S.C. § 103(a) as being unpatentable over Kageyama in view of Fenton. The United States Patent and Trademark Office bears the burden of factually supporting any *prima facie* conclusion of obviousness.⁵ An obviousness rejection must take into account the differences between applied art and the rejected claims.⁶ Courts disapprove of on hindsight reconstruction to discount these differences.⁷ Where the differences set the claims apart from the applied art, the claims are patentable.⁸ For several reasons, the current rejections do not show that the rejected claims are obvious over the applied art. Applicants discuss some of these reasons below.

A. Claims 1 – 9

User attributes and preferences are different from attributes of a user device

Claim 1 recites “performing media negotiation with a system associated with said second user device to inform a media delivery system of attributes of said second user device”⁹ Examiner cites to Kageyama, paragraphs [0025] and [0030] as teaching this limitation. As Applicant pointed out in the Response to the First Office Action, the attribute information of Kageyama does not relate to a device; it pertains to a user.¹⁰ In response to Applicant’s assertion that Kageyama’s attribute information does not pertain to a device, Examiner contends

⁵ . M.P.E.P. § 2142; *In re Peehs*, 612 F.2d 1287, 204 USPQ 835, 837 (CCPA 1980).

⁶ *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 15 - 17 (1966).

⁷ “A fact finder should be aware . . . of the distortion caused by hindsight bias”. See *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007) (citing *Graham*).

⁸ See *United States v. Adams* 383 U.S. 39, 48 (holding that the Government erred in concluding that wet batteries are old in the art because, among other things, “the fact that the Adams battery is water-activated sets his device apart from the prior art.”)

⁹ (emphasis added).

¹⁰ See Abstract (stating, “users’ attribute information to external devices and the input of others’ attribute information from external devices.”); paragraph [0060].,

that “user-identifying attributes and preferences information” means attributes of a second device because a “user must have preferences according to the device capability.” It is indisputable, however, that Kageyama makes clear what user preferences means:

“[T]he preference information contains information such as hobbies, preferences, favorite contents genres, favorite agencies (EC sites often used), and favorite users (persons with whom information is often exchanged).”¹¹

Kageyama’s definition of preferences does not include preferences according to the device capability. Because Kageyama makes it clear what “preference information” means, it is improper for Examiner to ascribe a different meaning to the phrase to facilitate the rejection of claim 1.

Moreover, Examiner notes that the M.P.E.P provides that “during examination, the claims must be interpreted as broadly as their terms reasonably allow.”¹² Having stated this rule, in the rejection of claim 1, Examiner interprets “attributes of said second user device” broadly but unreasonably to include user attributes and preferences. It is not reasonable to assert that user attributes and preferences are the same as, or a subset of, attributes of a user device. Therefore, the limitation pertaining to attributes of the second user device distinguishes claim 1 from the applied art which only teaches about user attributes and preferences.

The applied art does not store content to be delivered as claim 1 requires

Amended claim 1 requires “wherein said storing allows said media delivery system to accept information pertaining to said stored content” In Kageyama, the asserted content to be delivered—personal attribute information¹³ (which Examiner also asserts as attributes of a user device)—is not stored in a media delivery system as required by claim 1. Rather, this personal information is stored in the user terminal—the asserted user device.¹⁴ Examiner, apparently conceding that Kageyama does not teach the limitation regarding storing, previously

¹¹ Paragraph [0060].

¹² Office Action, page 3 (emphasis added).

¹³ See Office Action, page 8 (where Examiner asserts the negotiation of paragraph [0021] teaches accepting information with respect to content to be delivered); Abstract (“An object of the present invention is to provide a device capable of negotiation about the disclosure of attribute information.”).

¹⁴ Paragraph [0058] (stating that “a personal attribute information creation and management part 54 that stores and manages users’ attribute information . . .”).

recited in claim 7, relies on Fenton paragraph [0028] for teaching storing by the media delivery system.¹⁵ Examiner asserts that this portion of Fenton teaches that the “multimedia stores and forwards the message to users.”¹⁶

Fenton, however, teaches that its media delivery system receives, sometimes converts and delivers to a user the contents of a message destined to that user. In other words, Fenton discloses a relay system.¹⁷ A first user sends a message requesting delivery of that message to a second user. Fenton temporarily stores this message to facilitate the relay of the message from one user to the other and does not store content so that the media delivery system may accept information pertaining to the stored content to be delivered.

Examiner must consider the claim as a whole and not just cite art that merely teaches some form of storing.¹⁸ Contrasting claim 1 as a whole with the asserted combination shows that the asserted combination does not teach storing content in a media delivery system so that the media delivery system can receive information pertaining to the stored content, perform media negotiation, and configure the content for delivery. Absent the required storing, the asserted combination does not meet any of the subsequently recited limitations of claim 1.

Summary

Examiner has not shown that the applied art teach all the limitations of claim 1 because Kageyama’s user attributes and preferences are different from attributes of a user device. Additionally, Fenton does not store content so that information may be accepted regarding the content to be delivered, as required by claim 1. Claims 2 – 9 inherit these limitations of claim 1. For at least these reasons, claims 1 – 9 are patentable over the applied art. Applicant, therefore, respectfully requests that Examiner withdraw the rejection, under 35 U.S.C. § 103(a), of claims 1 – 9.

¹⁵ Office Action, page 13.

¹⁶ *Id.*

¹⁷ Paragraph [0028].

¹⁸ To properly ascertain the differences between the claims and the applied art as required under *Graham*, the claimed invention must be considered “as a whole.” *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593, 1595 – 96 (Fed. Cir.), *cert. denied*, 481 U.S. 1052.

B. Claims 10 – 42

Fenton's server does not receive a message that includes identification of certain content for sending

Claim 10 requires “a server . . . adapted to receive from a first user device . . . a message including identification of certain content for sending at least a portion of said stored content” Similarly, claim 32 requires “receiving, at said server, from a first user device of a plurality of user devices an abbreviated message including identification of certain content of said stored content for sending at least a portion of said stored content. . . .” Examiner asserts that Fenton, paragraph [0066], lines 36 – 38, Fig. 1, Fig. 10 and paragraph [0041], lines 1 – 7 teaches the limitations of claims 10 and 32 at issue.¹⁹

Piecing together these portions of Fenton, as Examiner has done, does not show Fenton teaches the limitations of claims 10 and 32 at issue. In piecing these different portions of Fenton together, Examiner has not considered the limitations or the claims as a whole. For example, Examiner relies on paragraph [0041] for teaching that a server receives a message.²⁰ Then, to address “identification” Examiner proceeds to point to paragraph [0066] and states that paragraph [0066] shows “means to uniquely identify the version number and message type in each abstract message.”²¹ There is no teaching there, however, that, a server receives a message that includes identification of certain content of the stored content for sending at least a portion of the stored content. In fact, paragraph [0066] states that the multi media message service environment (MMSE) provides the message identification only to MMS user agents. Significantly, Examiner has not shown that this identification is part of a message received by a server. In other words, Examiner has not shown that the MMS user agents or any other device sends this identification in a message to a server and this message is used for sending certain of stored content. Applicant submits that merely asserting that Fenton's MMSE provides a message identification to a user device does not show that a server receives a message that includes identification which is used for sending stored content.

¹⁹ Office Action, page 4.

²⁰ *Id.*

²¹ *Id.*

In sum, the applied art does not teach a server receives a message including identification for sending at least a portion of stored content. For at least this reason, claims 10 and 32 are patentable over the applied art. Claims 11 – 31 and 33 – 42 inherit all the limitations of claims 10 and 32 respectively and are, therefore, patentable. Accordingly, Applicant respectfully requests that Examiner withdraw the rejection under 35 U.S.C. § 103(a), of claims 10 – 42.

C. Claims 43 – 50

Fenton's element 126 does not receive a unique identification

Claim 43 requires, “distribution control apparatus for receiving from at least one of said users a unique identification of certain content of said stored content and for sending at least a portion of said uniquely identified content” Examiner cites to Fenton, Fig. 1, element 126 and paragraph [0028] as teaching this limitation of claim 43.²² These portions of Fenton, however, do not teach that element 126 receives a unique identification of certain content from a user and that element 126 sends at least a portion of this uniquely identified content.

Instead, paragraph [0041] provides that the MMSE sends the asserted identification to the users. Examiner has not shown and Applicant has not seen, in Fenton, where a user sends the asserted unique identification of certain content to element 126 and that element 126 sends at least a portion of the uniquely identified content. Therefore, Examiner has not shown that the applied art teaches the limitation of claim 43 requiring “distribution control apparatus for receiving from at least one of said users a unique identification of certain content of said stored content and for sending at least a portion of said uniquely identified content”

Because the applied art does not teach a distribution apparatus receives a unique identification of certain content and that the apparatus sends this uniquely identified content, claim 43 is patentable over the applied art. Claims 44 – 50 inherit all the limitations of claim 43 are, therefore, patentable. Accordingly, Applicant respectfully requests that Examiner withdraw the rejection under 35 U.S.C. § 103(a), of claim 43 – 50.

²² Office Action, page 10.

D. Claims 51 – 55

Fenton’s MMS User Agent does not identify multi media content having a unique identification

Claim 51 requires, “identifying at least a portion of multi-media content to a user, said portion having a unique identification associated therewith” Examiner asserts that based on Fenton paragraph [0066], Fenton’s MMS user agent identifies multimedia content having a unique identification and thus Fenton teaches the limitations of claim 51.²³ Examiner’s assertion is incorrect. Paragraph [0066] describes that:

If a MMS User Agent 102, 104, 106, 108, 110 and 112 supports submission of multimedia messages, the MMS User Agent . . . should: . . . identify the MIME content type of the message. . . .
Upon reception of a multimedia message from an originator MMS User Agent 102, 104, 106, 108, 110 and 112, the originator MMSE: will assign a Message Identification to the multimedia message²⁴

Thus, in Fenton, the MMS User Agents identify the content type of the multimedia—note content type is not a unique identifier. Then, the MMS User Agent sends the multimedia message to the MMSE. The MMSE then assigns a message identification to the multimedia message. Because the originator MMSE receives the multimedia message from the MMS User Agent, when the MMS User Agent identifies the MIME content type, Examiner’s asserted unique identification has not yet been applied to the multi media message. Fenton’s MMS user agent, therefore, does not identify multi media content that has a unique identification.

Examiner’s assertion that the MMS User agents represent the remote host and the user at the same time does not render claim 51 obvious

Claim 51 requires “under control of said user, sending a message to a host remote from said user . . . upon receipt by said host of said message from said user, delivering said MMS message . . . at least one proposed recipient.” Examiner asserts that Fenton’s Fig. 1 elements 102, 104, 106 and 108—MMS user agents—are equivalent to the claimed host system.²⁵

²³ *Id.*

²⁴ Fenton, paragraph [0066](emphasis added).

²⁵ Office Action, page 11.

Examiner, however, has not explicitly identified the user and the recipient with regard to this claim. It appears that Examiner is asserting that the MMS user agents represent the user, the recipient and the host remote system. Applicant submits that the fact that Examiner is interpreting the host remote to be the same as the user and the recipient illustrates the clear distinction between Fenton and claim 51 and thus Fenton cannot be used to render claim 51 obvious.

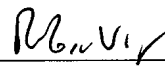
In sum, Examiner's reliance on MMS User Agents as functioning, at the same time, as a host remote, users and recipients illustrates that the applied art does not render claim 51 obvious. Claims 52 – 55 inherit all the limitations of claim 51 and, therefore, are also not obvious. Accordingly, Applicant respectfully requests that Examiner withdraw the rejection under 35 U.S.C. § 103(a), of claim 51 - 55.

VIII. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 64032/P006US/10303189 from which the undersigned is authorized to draw.

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Respectfully submitted,

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